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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,419	04/23/2001	Werner Blumenstock	Q63542	3448

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037-3213

EXAMINER

NGUYEN, DUC M

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,419

Applicant(s)

BLUMENSTOCK ET AL.

Examiner

Duc M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

This action is in response to applicant's response filed on 10/7/04. Claims 1-22 are now pending in the present application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Wookey** (US Pat. Number **6,085,244**) in view of Naugle (US 5,715,393).

Regarding claims **1-6, 9-16, 18-22**, **Woodkey** discloses a method for remote diagnosis of an automation system, which would comprise all the claimed limitations (see entire document), wherein **Woodkey** discloses

- a firewall system (see **col. 5, lines 16-25**);
- monitoring software and new test instructions (see **col. 6, lines 32-52**);
- automatic executing the test and automatic return the test result (see **col. 3, lines 1-6, col. 8, lines 42-52, and col. 9, lines 7-10**);
- data encryption and decryption for communication (see **col. 10, lines 34 – 65**);

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- the instruction is at least one of to control, operate and monitoring the application of the system (see **col. 11, lines 29-67**);

Here, although the general description of the remotely monitoring system as described by **Woodkey** appears more dedicate to a dial-up modem link, it is noted that **Woodkey** does mention the use of an e-mail message as a communication link (see **col. 4, lines 13-16**). Since using an email message for diagnosis is known in the art as disclosed by **Naugle** (see **Abstract, Fig. 2 and col. 4, line 1 – col. 5, line 60**), and since **Woodkey** does mention the use of an e-mail message, it would have been obvious to one skill in the art to combine the above teachings of **Naugle** and **Wookey** for providing a diagnosis system utilizing an email message for diagnosis as claimed, for being able to monitor the correct operation of a remote computer system without requiring a log on to that system (see **Naugle, col. 5, lines 54-60**).

Regarding claims **7-8, 17**, the claims are rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Woodey** and **Naugle** as modified would disclose address field, sender field, date and time field, and subject field as claimed (see **Naugle, col. 4, lines 15-67**).

3. Claims **1-22** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Kuwabara** (US Pat. Number **6,065,136**) in view of **Wookey** (US Pat. Number **6,085,244**).

Regarding claim **1**, **Kuwabara** discloses a system for remote diagnosis of device troubles, wherein electronic mail (e-mail) messages for sending the

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instruction and receiving diagnosis results are utilized (see **Fig. 1** and **col. 5, line 63 - col. 6, line 35**), which would include all the claimed limitations except for a firewall and automatic monitoring feature. However, it is clear that the system as described by **Kuwabara** would work equally well in an automatic monitoring system comprising a firewall as disclosed by **Wookey** (see **Fig. 3, col. 2, line 54 - col. 3, line 17** and **col. 5, lines 16-37**), wherein the diagnosis results are also reported via the internet utilizing e-mail messages (see **col. 4, lines 13-17** and **col. 22, lines 16-20**). Therefore, it would have been obvious to one skill in the art to combine the above teachings of **Wookey** and **Kuwabara** for providing a secured (firewall) system with automatic monitoring features as claimed, for reducing or eliminating required intervention by the customer and the service center both to collect the system diagnostic information, and to process it (see **Wookey, col. 3, lines 7-17**). Here, when incorporating the diagnosis of device in **Kuwahara** to **Wookey's** system, it is clear that the instruction program should be modified to execute the instruction automatically as teach by **Wookey** since the required intervention by the customer has been eliminated.

Regarding claim **2**, the claim is rejected for the same reason as set forth in claim **1** above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the instruction comprises at least one function as claimed, for diagnosis purpose.

Regarding claim **3**, the claim is rejected for the same reason as set forth in claim **1** above. In addition, it is clear that **Kuwabara** and **Wookey** would

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discloses the application comprises a component (hardware) as claimed, in order to run an application.

Regarding claim 4, the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the first and second E-mail messages as claimed, in order to send the instruction and receive diagnosis results for diagnosis purpose.

Regarding claim 5, the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the configuration as claimed, for diagnosis purpose.

Regarding claim 6, the claim is rejected for the same reason as set forth in claim 5 above. In addition, it would have been obvious to one skill in the art to modify the above teachings of **Wookey** and **Kuwabara** for encrypting/decrypting e-mails as claimed, for security purpose as disclosed by **Wookey** (see col. 10, lines 34-43, 55-65).

Regarding claim 7, the claim is rejected for the same reason as set forth in claim 1 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the identification field and text field as claimed (see **Kuwabara**, Figs 3-4).

Regarding claim 8, the claim is rejected for the same reason as set forth in claim 7 above. In addition, it is clear that **Kuwabara** and **Wookey** would disclose the address, sender, date and time, and text fields as claimed (see Figs 3-4), for administration purpose.

Regarding claims 9-22, the claims are interpreted and rejected for the same reason as set forth in claims 1-8 above, wherein **Kuwabara** and **Wookey**

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would disclose the instruction is at least one of to control, operate and monitoring the application of the system (see **Wookey, col. 11, lines 29-67**);

Response to Arguments

4. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (703) 306-4531, Monday-Thursday (9:00 AM - 5:00 PM). Or to Edward Urban (Supervisor) whose telephone number is (703) 305-4385.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Duc M. Nguyen

Dec 3, 2004

A handwritten signature in black ink, appearing to read "Duc M. Nguyen", with a long horizontal flourish extending to the right.